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COPY MAILED
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In re Application of :
John Dash :
Application No. 10/616,165 : ON PETITION
Filed: July 7, 2003 :

This is a decision on the portion of the petition, filed July 21, 2008, related to the abandonment of the application, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application. The request for reclusal of persons associated with the subject matter and aspects of the above-identified application will be addressed separate from this petition decision by the Technology Center Director.

The petition to withdraw the abandonment is **DISMISSED**.

Any request for reconsideration of this decision should be submitted within two (2) months from the mail date of this decision and be entitled "Renewed Petition to Withdraw the Holding of Abandonment under 37 CFR 1.181." *See* 37 CFR 1.181(f).

On October 15, 2007, the Office mailed a requirement for an election of species, which set a one month shortened statutory period to reply. A Request for Suspension of Period of Reply was filed November 5, 2007 and included remarks directed to the election requirement. On March 12, 2008, the Office informed applicant that the Request for Suspension of Period of Reply was denied as improper. Applicant then requested reclusal of persons associated with the subject matter and aspects of the above-identified application through a letter filed May 5, 2008. On June 18, 2008, the Office mailed a Notice of Abandonment.

In the present petition, petitioner asserts that the required election was made within the Request for Suspension of Period of Reply filed November 5, 2007. This assertion is construed as a request that the Office withdraw the holding of abandonment since, allegedly, the reply was timely filed.

DISCUSSION OF PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

Where an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, or as to controlling dates), a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee. See the Manual of Patent Examining Procedure (MPEP) 711.03(c)(I). Such a petition may be granted where the petition provides sufficient evidence to establish that a reply to an office action, such as the election requirement mailed October 15, 2007, was mailed or filed by the applicants.

In this case, applicant was required to first elect between species A, wherein the electrolyte is heated only, and species B, wherein the electrolyte is both heated and caused to become radioactive. See section "2" of the requirement mailed October 15, 2007. Then, after election of either species A or species B, applicant was further required to elect a single species of the cathode material. See section "3" of the requirement mailed October 15, 2007. Applicant was also advised that

> "**the reply to this requirement to be complete must include (i) an election of a species to be examined** even though the requirement may *be traversed* (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election." [emphasis in original]

The election requirement was addressed on pages 5 and 6 of the Request for Suspension of Period of Reply filed November 5, 2007. In particular, the portion of that request that petitioner asserts satisfied the election requirement states:

> "So as to avoid an improper claim of abandonment an election of whatever the Offices considered to be the species of claim 13 is elected and is traversed for the reasons indicated herein. So as to avoid any further questions of whether or not this document is responsive it is noted that considered claims 14 to 20, inclusive are dependent under claim 13 and, hence, if claim 13 is held to in fact relate to a species they also relate to this same species. Claim 21 in substance merely adds to claim 13. Under the circumstances how can it relate to a different species, particularly when the specification makes it clear that during the operation of he process both heat and radioactivity are concurrently produced as the process is carried out?"

This statement in the Suspension of Period of Reply filed November 5, 2007 is not a proper election. Applicant was required to elect between a species in which the electrolyte is heated only and a species in which the electrolyte is both heated and caused to become radioactive, and not elect between claims. The statement that "the species of claim 13 is elected" does not satisfy this requirement even though a claim was parenthetically referenced in the election requirement. Moreover, a second election was then required of a single species of the cathode material, but this second election was not provided. Applicant indicated that "if claim 13 is held to in fact relate to a species [claims 14-20] also relate to this same species." While this statement

identifies claims encompassed by claim 13, it does not identify an elected species of cathode material. At best, this statement could be construed as an argument that claims 14-20 are generic, which is considered non-responsive when not accompanied by an election. Accordingly, the application became abandoned on November 16, 2007, one month after the mailing of the election requirement. This abandonment occurred as a matter of law for failure to timely and properly respond to the Notice. Abandonment did not occure at the discretion of the examiner.

ALTERNATIVE VENUE

Where there is no dispute as to whether an application is abandoned (e.g., the applicant's contentions merely involve the cause of abandonment), a petition under 37 CFR 1.137 (accompanied by the appropriate petition fee) is necessary to revive the abandoned application. See the MPEP 711.03(c)(I).

Petitioner is encouraged to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application instead of filing a renewed petition under 37 CFR 1.181 or a petition under 37 CFR 1.137(a).

For a utility application filed on or after June 8, 1995, such as the present application, a grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) The reply, in the form of a proper election, required to the outstanding Office action;

(2) The petition fee as set forth in 37 CFR 1.17(m) (currently **$810.00** for a small entity); and

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

A form for filing a petition to revive an unintentionally abandoned application accompanies this decision for petitioner's convenience. If petitioner desires to file a petition under 37 CFR 1.137(b) instead of filing a request for reconsideration of the petition under 37 CFR 1.181, petitioner must complete the enclosed petition form (PTO/SB/64) and pay the $810.00 petition fee.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries related to this decision may be directed to Christopher Bottorff at (571) 272-6692.

David Bucci
Petitions Examiner
Office of Petitions

Enclosures: Form PTO/SB/64, Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b).

PTO/SB/64 (10-08)
Approved for use through 11/30/2008. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

Docket Number (Optional)

First named inventor:

Application No.: Art Unit:

Filed: Examiner:

Title:

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee;
(2) Reply and/or issue fee;
(3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
(4) Statement that the entire delay was unintentional.

1.Petition fee

☐ Small entity-fee $ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity – fee $ _____ (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of _____(identify type of reply):

☐ has been filed previously on _____.
☐ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of $ _____.

☐ has been paid previously on _____.
☐ is enclosed herewith.

3. Terminal disclaimer with disclaimer fee

☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $ _____ for a small entity or $ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

_____ Signature

_____ Date

_____ Typed or printed name

_____ Registration Number, if applicable

_____ Address

_____ Telephone Number

_____ Address

Enclosures: ☐ Fee Payment

☐ Reply

☐ Terminal Disclaimer Form

☐ Additional sheets containing statements establishing unintentional delay

☐ Other: _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

_____ Date

_____ Signature

_____ Typed or printed name of person signing certificate

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.